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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/363,413	07/29/1999	ADDISON M. FISCHER	264-169	8101

23117 7590 11/03/2005

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EXAMINER

JACKSON, JENISE E

ART UNIT PAPER NUMBER

2131

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/363,413	<b>Applicant(s)</b> FISCHER ET AL.	
	<b>Examiner</b> Jenise E. Jackson	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 57-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 57-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 57-108 are rejected under 35 U.S.C. 102(e) as being anticipated by Sims, III(6550011).

3. As per claims 57, 83, Sims, III discloses a method of transferring authorization to render protected electronic content from a first device to a second device having a device cryptographic key(see col. 10, lines 43-64, col. 17, lines 54-61), receiving a transfer authorization request having an indicator of the first device, and indicator of the second device, and an indicator of the protected electronic content (see col. 17, lines 62-67, col. 18, lines 1-17); updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate the second device is authorized to render the protected electronic content based on the received transfer authorization request(see col. 11, lines 34-47, col. 15, lines 5-22, col. 18, lines 3-18); and communicating a transfer authorization response having an indicator of the second device, an indicator of the protected electronic content, and a content cryptographic key for the protected electronic content protect using the device cryptographic key of the second device so that only the second device may gain

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access to the content cryptographic key by use of the device cryptographic key of the second device(see col. 18, lines 1-18, 52-61).

4. As per claim 58, Sims III discloses wherein the device cryptographic key of the second device is a symmetric key(see col. 4, lines 7-17).

5. As per claim 59, Sims III discloses wherein the device cryptographic key of the second device is a DES key(see col. 5, lines 19-33).

6. As per claim 60, Sims III discloses wherein the device cryptographic key of the second device is a public key having a corresponding private key stored with the second device, and protecting the content cryptographic key suing the device cryptographic key of the second device includes protecting the content cryptographic key with the public key such that the second device may use the corresponding private key to gain access to the content cryptographic key(see col. 17, lines 62-67, col. 18, lines 1-17).

7. As per claim 61, Sims III discloses wherein the public key is an RSA public key and the private key is an RSA private key(see col. 4, lines 7-17).

8. As per claim 62, Sims III discloses wherein the content cryptographic key is a symmetric key, which is used to encrypt the protected electronic content such that only the symmetric key can be used to decrypt the content(see col. 3, lines 66-67, col. 4, lines 1-46).

9. As per claim 63, Sims III discloses receiving payment authorization information associated with the transfer authorization request, and charging a service fee based on the payment authorization information (see col. 9, lines 25-43).

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10. As per claim 64, Sims III discloses wherein updating the first device history table includes removing a stored indicator of the protected electronic content from the first device history table(see col. 11, lines 34-47, col. 15, lines 5-22).

11. As per claim 65, Sims III discloses wherein the updating the first device history table includes adding indicia that the protected electronic content is no longer authorized for the first device(see col. 11, lines 34-47, col. 15, lines 5-22).

12. As per claim 66, Sims III discloses wherein the protected electronic content is audio content(see col. 8, lines 51-56).

13. As per claim 67, Sims III discloses wherein the protected electronic content is video content(see col. 8, lines 51-55).

14. As per claim 68, Sims III discloses wherein the protected electronic content is electronic written content(see col. 8, lines 51-58).

15. As per claim 69, Sims III discloses wherein the indicator of the first device in the transfer authorization request is a unique serial number(see col. 17, lines 44-49).

16. As per claim 70, Sims III discloses verifying that the first device is authorized to render the protected electronic content(see col. 17, lines 24-35).

17. As per claim 71, Sims III discloses a method of providing authorization to render protected electronic content to a second device in addition to previously providing authorization to render the protected electronic content to a first device(see col. 17, lines 54-61), receiving an authorization to render request having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content(see col. 17, lines 62-67, col. 18, lines 1-17); updating a second device history table to indicate that the second device is authorized to

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render the protected electronic content based on the received authorization to render request, a first device history table indicating that the first device remains authorized to render the protected electronic content(see col. 15, lines 5-22, col. 18, lines 1-18, 52-61); and communicating an authorization to render response having an indicator of the second device, an indicator of the protected electronic content, and a content cryptographic key for protected electronic content protected using a device cryptographic key of the second device so that only the second device may gain access to the content cryptographic key by use of the device cryptographic key of the second device(see col. 17, lines 62-67, col. 18, lines 1-17).

18. As per claim 90, Sims III discloses a system of providing authorization to render protected electronic content to a second device in addition to previously providing authorization to render the protected electronic content to a first device(see col. 17, lines 54-61), an input for receiving an authorization to render having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content(see col. 17, lines 62-67, col. 18, lines 1-17); a processor for updating a second device history table to indicate that the second device is authorized to render the protected electronic content based on the received authorization to render request, a first device history table indicating that the first device remains authorized to render the protected electronic content(see col. 15, lines 5-22); and an output for communicating an authorization to render response having an indicator of the second device(see col. 18, lines 3-18); and indicator of the protected electronic content, and a content cryptographic key for the protected electronic content using a device cryptographic key of the second device so that only the second device may gain access to the content cryptographic key by use of the device cryptographic key of the second device(see col. 17, lines 62-67, col. 18, lines 1-17).

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19. As per claim 97, similar limitations have already been addressed (see claim 90). Also, claim 97, discloses obtaining access to the content cryptographic key through decryption using the device cryptographic key of the second device and obtaining access to the protected electronic content thorough decryption using the content cryptographic key(see col. 17, lines 62-67, col. 18, lines 1-25).

20. As per claim 98, similar limitations have already been addressed(see claim 90). Also, claim 97, discloses obtaining access to the content cryptographic key in the first device thorough decryption using the first device cryptographic key and obtaining access to the protected content thorough decryption using the content cryptographic key(see col. 17, lines 62-67, col. 18, lines 1-25).

21. As per claim 99, Sims III discloses a system in which protected content such as audio is protected by having a cryptographic key(see col. 8, lines 51-58). Also, as per claim 99, for use with first and second interface devices for insertion into at least one audio tape player having a plurality of user controls and for responding to user actuation of the one of the controls to place the audio tape player in a state to initiate a selected operation when a conventional audio cassette has been inserted into a tape player, inherent because Sims discloses audio data(see col. 8, lines 51-58, col. 12, lines 43-56).

22. As per claim 100, limitations have already been addressed (see claim 71 and 90). In regards to the audio content, it has already been addressed (see claim 99).

23. As per claim 101, Sims III discloses wherein the first and second devices are devices, which may be inserted into a tape player having a plurality of conventional user controls(see col. 8, lines 51-58, col. 12, lines 43-56).

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- 24. As per claims 72, 84, 91, are rejected under the same basis as claim 58.
- 25. As per claim 73, it is rejected under the same basis as claim 59.
- 26. As per claims 74, 85, 92 are rejected under the same basis as claim 60.
- 27. As per claim 75, it is rejected under the same basis as claim 61.
- 28. As per claims 76, 86, 93 are rejected under the same basis as claim 62.
- 29. As per claims 77, 87,94, are rejected under the same basis as claim 63.
- 30. As per claim 78, it is rejected under the same basis as claim 66.
- 31. As per claim 79, it is rejected under the same basis as claim 67.
- 32. As per claim 80, it is rejected under the same basis as claim 68.
- 33. As per claims 81, 88, 95 are rejected under the same basis as claim 69.
- 34. As per claims 82, 89, 96 are rejected under the same basis as claim 70.
- 35. As per claims 102-106, same limitations as claim 101.
- 36. As per claim 107-108, Sims discloses wherein the first device is no longer authorized to render the protected electronic content upon transfer of authorization to render the protected electronic content from the first device to the second device(see col. 18, lines 3-16).

***Response to Amendment***

- 37. The Applicant states that the priority date of August 5, 1998 is not the priority date of the reference(6,550,011). The Examiner disagrees with the Applicant. The reference 6,550,011, has a priority date of August 5, 1998 as this continuation in part reference qualifies as prior art. Thus, this point is moot.
- 38. The Applicant states that Sims does not disclose receiving a transfer authorization request, let alone the transfer authorization request having an indicator of a first device, and an



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indicator of a second device, and an indicator of the protected electronic content. The Examiner disagrees with the Applicant. The host device request the destination device's public key in order to confirm the identity of the device authorized by the content provider(see col. 17, lines 1-9). The indicators are the keys that the devices possess. There is a content key associated with the protected electronic content in order to decrypt(see col. 18, lines 3-5). The two devices have an encryption key and decryption key(see col. 17, lines 63-67, col. 18, lines 1-16).

39. The Applicant states that Sims does not disclose a first device history table to indicate that the first device is not authorized to render the protected content. The Examiner disagrees with the Applicant. The device history table in Sims, contains a list of device that are authorized and non-authorized to receive protected content(see col. 15, lines 4-45). The indications include what devices are authorized from copying, and contain a limit on how many copies can be made, each content has a watermark ID(see col. 15, lines 4-21). Sims also, discloses that a list of devices authorized is compiled and identified (see col. 15, lines 22-31). Each device has a history in the list, so that the first device, second device, etc. is in the table of Sims(see col. 15, lines 4-45).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E. Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



October 28, 2005



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